



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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AUG 12 2002

Paper No. 20

In re Application of :  
Frampton Ellis, III : DECISION ON PETITION  
Application No. 09/527,019 :  
Filed: March 16, 2000 :  
Attorney Docket No. ANAT-15US2 :

This is a decision on the petition filed on August 6, 2002 by which petitioner requests withdrawal of the examiner's objection to the drawings as failure to illustrate certain features of the invention as claimed. The petition is considered to be timely as it has affixed thereto a 37 CFR 1.8(a) certificate of mailing dated July 22, 2002. No fee is required for the petition.

The petition is granted-in-part.

In the final office action dated January 2, 2002, petitioner received an objection to the drawings pursuant to 37 CFR 1.83(a) as failing to illustrate certain features of the invention as claimed in claim 4 and in claim 14. The objection also required petitioner to file drawings which illustrated those features, or to cancel them from the claims. See paper No. 12, first paragraph on page 2. In that same objection, the examiner noted that drawing Figure 11Q, filed on October 5, 2001 as part of petitioner's response to an identical requirement promulgated in paper No. 7, did not satisfy the requirement with respect to certain of the claimed features.

Petitioner requests relief from the requirement on the grounds that in paper No. 12, the examiner refers to the features of claim 4, which had been canceled from the application by petitioner's October 5, 2001 response, notwithstanding that petitioner admits that the features in question are recited in pending claim 24. Petitioner also complains that no explanation for the examiner's disapproval of drawing Figure 11Q was provided, as is allegedly required by MPEP 608.02, Examiner Note No. 3. Petitioner argues that Figure 11Q clearly illustrates "mechanical fasteners, a snap fit, interlocking geometries, and combinations thereof" because the examiner admits that the drawing is a schematic of those features. Petitioner relies upon 37 CFR 1.81(b) to the effect that "drawings may include illustrations which facilitate an understanding of the invention" and alleges that Figure 11Q satisfies this requirement.

As to the features of claim 14, petitioner notes that the computer controller which the examiner holds to be absent from the drawings is not recited in claim 14, although petitioner admits that this feature is recited in claims 12 and 13. Petitioner also argues that Figure 11P in fact illustrates the features of claims 12 and 13.

It is clear that Figure 11P illustrates the subject matter of claims 12 and 13 adequately. Therefore, the objection set forth in paper No. 12 is hereby vacated with respect to claims 12 and 13 and Figure 11P.

However, a review of the drawings, the claims and the specification shows that the examiner's objection to drawings as failing to illustrate the subject matter which is now recited in claim 24 is well taken. As a preliminary matter to a discussion of why, it is noted that the fact that the examiner did not state the correct claim numbers in his action is hardly laudable. But on the other hand, it is abundantly clear that petitioner understood the basis for the examiner's rejection. It is noted that petitioner argued persuasively with respect to the features of claims 12 and 13 being properly illustrated in Figure 11P, and was not precluded from doing so despite the examiner having misidentified these claims as being claim 14.

Petitioner's argument with respect to failing to supply adequate reasoning why the drawings do not adequately illustrate the subject matter now recited in claim 24 is not completely understood, because it is far from clear what petitioner means by "Examiner Note 3" in MPEP 608.02. However, the action clearly states all of the rationale required of the examiner, namely that certain subject matter is claimed, but isn't illustrated. In this regard, petitioner should note that is relying upon 37 CFR 1.83, and not 37 CFR 1.81.

Petitioner should further note that 37 CFR 1.83 permits the use of schematic representation only to represent "conventional features" which are not essential to a proper understanding of the invention. Claim 24 does more than merely enumerate "mechanical fasteners, a snap fit, interlocking geometries, and combinations thereof." It specifies, albeit broadly, certain relationships between those elements and other elements of the claims. Proposed Figure 11Q does not illustrate those relationships adequately. And therefore, the drawings do not properly illustrate the subject matter of claim 24.

*Ex Parte Good*, 1911 C.D. 43, 164 O.G. 739 (Comm'r Pat. 1911) is instructive as to why instances that every claimed feature of the drawings must be adequately illustrated, to include their relationship and manner of cooperation with other claimed features even where certain of the features are "conventional". As stated in *Good*

"The question is not whether one skilled in the art can decipher the invention, but whether the drawing is so clearly and artistically executed as to facilitate a ready understanding of the invention both at the time of examination and in searches afterward in which reference to the patent must be made." (Emphasis supplied.)

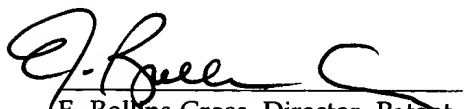
To the same effect is *Ex Parte Sturtevant et al*, 1904 C.D. 26, 108 O.G. 563 (Comm'r Pat. 1904) in which it is stated:

"It is a great desideratum of Patent Office drawings that they should tell their story to the eye without making it necessary to go into the specification for explanation, which should be apparent upon inspection. ... "

Merely because certain claimed elements are *per se*, there is no basis for holding that they can be shown as schematics only, when the claims require cooperation between those features and other claimed features. In the words of the *Sturtevant* decision, the "...necessity for such representation of the invention in the drawings as will make it intelligible for the purposes of search" is an important consideration. Figure 11Q may well show that the above mentioned elements of claim 24 are present in the disclosure of this application, but it clearly fails to illustrate the cooperation between those elements and other claimed features. The requirements of 37 CFR 1.83(a) must be met to facilitate searching, and to further the cause of clear and unambiguous disclosure.

For the foregoing reasons, this application is being returned to the examiner for action on the appeal brief filed on July 18, 2002. The examiner is to consider that the objection with respect to the failure to illustrate the subject matter of claims 12 and 13 is vacated. However, the objection with respect to the failure to illustrate the subject matter recited in claim 24 is to be maintained. Petitioner may file a request for reconsideration of so much of this decision that denies a portion of the relief requested by petitioner, provided that the request for reconsideration is filed within two months of the date of this decision.

GRANTED-IN-PART

  
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